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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/713,161	11/14/2000	Sundaresan Jayaraman	GTRC77	3391

6980 7590 10/23/2002

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EXAMINER

RUDDY, DAVID M

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 10/23/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/713,161

Applicant(s)

JAYARAMAN ET AL

Examiner

David M Ruddy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,3,4,5,7,9,11,14,16,18,20,22,24,28,30, and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Flick (patent # 5,374,283). Flick discloses an electrode fabric/garment device comprising (as explained in column 2, lines 50-66) conductive fibers formed of woven and knitted fiber networks consisting of nylon and metal. Flick further discloses a garment type embodiment of a conductive fiber network as seen in figures 1-8. As seen in figure 1 and the disclosure relevant thereto, Flick discloses the steps of connecting the garment to a monitor and/or an impulse generator stimulator.

Flick further discloses a snap type connector lead connecting the fabric to a data output terminal as embodied by elements 24,25,32,44, and 45.

Claims 1-33 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Post et al (patent #6,210,771).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 6, 8, 10, 12, 15, 17, 19, 21, 23, 25, 29, 31, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flick. With reference to the above rejections Flick discloses all that is claimed except the expressed disclosure of using a conductive paste between the fiber and the data output lead.

The examiner takes official notice of the old and notorious use of conductive pastes, creams, gels etc. to aid in the electrical conduction (to or from a patient) of a biomedical signal or impulse. The use of such electrolytes are known to increase signal conduction and quality by reducing contact impedance between elements. Accordingly, the use of conductive paste with the device of Flick would have been obvious to one having ordinary skill in the art.

Response to Arguments

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a single layer of fabric (see lines 5-8 of page 5 of the response dated 4/30/2002), or the method of preparing the conductive fibers (see lines 14-21 on page 5 of the

response dated 4/30/2002) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant is referred to section 2113 of the MPEP regarding the interpretation of so called "product-by-process" claims with regard to the patentable weight which would be given to an amendment including product-by-process limitations (such as those argued at lines 14-21 on page 5 of the response dated 4/30/2002).

In response to Applicant's papers and declaration submitted on 9/20/2002, it is the examiner's position that the declaration submitted under 37 C.F.R. 1.131 has overcome the rejections based upon the reference of Jayaraman et al. (patent #6,145,551). The attestations submitted on 9/20/2002 set forth that the present invention is a continuation of the work described in patent #6,145,551 and that the present inventors, who are both named as co-inventors of the 6,145,551 patent, are the inventors of the present invention. Accordingly Applicants have overcome the previous rejection under 35 U.S.C. 102(e) by setting forth that the invention of patent 6,145,551 is not the invention of "another".

The examiner disagrees however, with Applicant's assertion that the present claims find support under 35 U.S.C. 112 all the way back to the effective filing date of the 6,145,551 patent (i.e. 9/22/1997).

Reference is made to section 706.02 of the M.P.E.P. which states in relevant part "If the application is a continuation-in-part of an earlier U.S. application, any claims in

the new application not supported by the specification and claims of the parent application have an effective filing date equal to the filing date of the new application. Any claims which are fully supported under 35 U.S.C. 112 by the earlier parent application have the effective filing date of that earlier parent application."

The examiner agrees that in order to obtain the benefit of a prior disclosure, the prior application need not provide "ipsis verbis" reference to a particular item. That being said, the examiner does not believe that a term such as that of "information infrastructure", which is not seen as an art recognized term, can be said to be supported by applicant's reference to a "personal status monitor" or the sensing materials disclosed in column 6, lines 62-67 of the 6,145,551 patent.

It is further noted that not only does patent #6,145,551 not include any mention of the term "information infrastructure" which is found in current claims 13, 26, and 27, nowhere does patent #6,145,551 include any recitation of the terms "impulse", "individually", "motherboard", "data-output", "terminal" or even "lead" which are interspersed throughout the claims. These points are not meant to be seen as claim rejections under 35 U.S.C 112, they are made in order to simply point out that the present claims will not find support back to the 9/22/1997 effective filing date of the 6,145,551 patent (leaving the current claims with an effective filing date of either 5/13/1998 or 11/14/2000).

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Conclusion

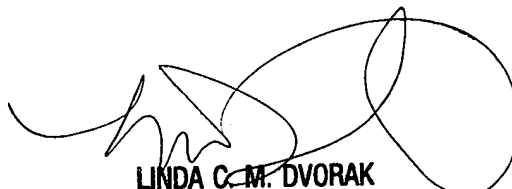
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The reference of Lebby et al. discloses a conductive fabric similar to that of the present application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M Ruddy whose telephone number is (703) 308-3595. The examiner can normally be reached on Mon-Fri 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (703) 308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-3376 for regular communications and (703) 746-3376 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

DR
October 21, 2002



LINDA C. M. DVORAK
SUPERVISORY PATENT EXAMINER
GROUP 3700